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Patent

REMARKS

The Examiner is thanked for the comments in the Action. They have helped us considerably in understanding the Action and in drafting this Response thereto.

It is our understanding that claims 1-15 remain pending in this application.

We respectfully ask entry of the amendment to [Para 1] herein to include relevant factual data. No new subject matter is added by this amendment.

We proceed now with reference specifically to the numbered items in the Action.

Item 1 (Objections to the Disclosure):

The Action states:

1. The disclosure is objected to because of the following informalities:

Re Para 2, line 4: Replace "rotationally disk" with -- rotationally in a disk --.

Re Para 8, line 4: Replace "which." with -- which, --.

Re Para 8, line 5: Replace "Accordingly," with -- Accordingly, the --.

Appropriate correction of these and similar errors is made by amendment herein. No new subject matter is added by these amendments.

The Action next states "*Further, the Examiner notes that the specification contains bolded and bracketed headings (such as Para 1) for each paragraph. Appropriate correction is required.*" Respectfully, "correction" would be inappropriate because the "headings" being objected to are added automatically by the Office's own ABX electronic filing software.

Item 2 (Double Patenting 1/3):

The Action states:

2. Claims 1-5 and 8-12 are rejected under the judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,561,420. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '420 patent, and the differences are well known and obvious in the art, and do not patentably distinguish the present claimed invention.

For instance in claim 1 of the present claimed invention and claim 1 of the '420 Patent, the Applicants claim:

i) "A system for distributing data ... front surface ... back surface ... four edges ... one stripe zone ... ring zone ... magnetically recorded instances of data ... read mechanism." (see claim 1), whereas in the '420 Patent, the Applicants claim "A system for distributing data ... front surface ... back surface ... four edges ...

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one stripe zone ... ring zone ... magnetically recorded instances of data ... read mechanisms.” (see claim 1).

Though the current claimed invention differs from the ‘420 Patent in that it calls for a stationary read mechanism, the Examiner notes that such modification is well known and obvious in the art, (stationary readers) and that such modification does not patentably distinguish the present claimed invention.

Respectfully, this is error under at least the following technical and legal rationales.

Under a technical analysis, the claims recite a reader including a stationary read mechanism, while claim 1 of the ‘420 patent recites a reader including a linear or a rotational read mechanism. What has been overlooked is that, taken in context here, one of ordinary skill in the art would appreciate that a stationary read mechanism is not an obvious substitute for a linear or a rotational read mechanism. In the case of the linear mechanism, the “*reader 14 may read data by moving the information card 12 linearly*” and in the case of the rotational mechanism, “*the reader 14 may read data by rotating the information card 12*” (see e.g., [Para 31], ln. 5-8 and FIG. 1a of the present application; and col. 5, ln. 8-12 and FIG. 1 of the ‘420 patent). And in the case of a stationary read mechanism, “*the reader 14 [reads] data from a stationary information card 12*” (see e.g., [Para 31], ln. 11-12 and FIG. 1b).

Particularly relevant to the overall context here, claim 1 of the ‘420 patent recites:

said stripe zones being aligned parallel with opposed said edges of said information card and being readable with respect to the data recorded therein by passing said information card through a linear read mechanism;

said ring zone being centered about a central axis through said information card with respect to said edges and being readable with respect to the data recorded therein by passing said information card through a rotational read mechanism;

whereas claim 1 of the present application contains no such limitations, because such are unnecessary with a stationary read mechanism.

Turning next to a legal analysis, it should be clear from the above that claim 1 of the ‘420 patent has on a reader wherein a card is moved and the claimed invention has on a reader wherein a card is stationary. Moving a card and holding one stationary are clearly different principles of operation. The courts have held that a substitution or combination cannot be obvious when different principles of operation apply (see e.g., *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); see also, MPEP 2143.01).

Turning now to another legal analysis, MPEP 804 at II.B.1 guides us:

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A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination.

This "parallel" rather than "same" analysis for obviousness is stressed in the case law and in repeatedly in the MPEP, but without providing a good clarifying example. We urge that the distinction becomes clear, however, by looking at why obviousness-type double patenting is considered wrong. As correctly stated in the Action:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.

Thus, what is the harm here? There will be no timewise extension of rights if the present claims are allowed, because the term of such a patent cannot exceed the term of the '420 patent. Also, harassment by multiple assignees will not be possible here, because the claims of the '420 patent are specifically limited to linear or rotational read mechanisms wherein a card is moved and the present claims are specifically limited to a stationary read mechanism wherein a card is stationary. These are mutually exclusive.

With respect to claim 9, we urge that it is allowable under the same rationales provided above for claim 1.

With respect to claims 2-5, 8, and 10-15 we urge that these are allowable for at least the same reasons stated above for their parent claims 1 and 9.

Item 3 (Double Patenting 2/3):

The Action states:

3. Claims 6 and 13 are rejected ... as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,561,420 in view of U.S. Patent No. 5,942,744.

Though the '420 Patent is silent to a data orientator, the Examiner notes that such orientations are well known and conventional in barcodes, magnetic stripes, and ring zones. Such orientators can take the form of a recognizable string of data indicating an orientation, or can take the form of a physical mark detected to determine orientation. Specifically, the '744 Patent teaches (col 39, lines 58+) data orientators to permit a card to be inserted and read regardless of orientation. Accordingly, it would have been obvious to an Examiner of ordinary

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skill in the art to combine the teachings. in order to permit reading of a card regardless of orientation.

As a preliminary item, we note that the legal standard is not what “*would have been obvious to an Examiner of ordinary skill in the art.*” ;-). We trust that the Examiner meant to say ‘would have been obvious to a person of ordinary skill in the art’ and we respond accordingly.

Next, we respectfully suggest that the actual elements in Applicant’s claims have been misinterpreted. For example, claim 6 recites “*at least one of said zones further includes at least one data orientator to permit reading the data regardless of a relative orientation of said information card relative to said stationary read mechanism.*” But claim 6 depends on claim 1, which recites “*a reader including a stationary read mechanism*” (to read data from a stationary card). Thus, the data orientator is present in a zone wherein data is stored magnetically, yet there seems to have been confusion with Applicant’s indicia (humanly visible information). The data orientator also permits reading “*regardless of a relative orientation of [a] card relative to said stationary read mechanism.*” Thus, the data orientator is not used to instruct a user to physically orient a card prior to reading, contrary to what the Action apparently states.

Furthermore, what the ‘744 patent does teach is a physical card-placement-based solution to work in a read mechanism that is clearly not stationary in operation. For example, at col. 39, ln. 64-66 “*the rotation direction of a recording track 63 with respect to a magnetic head ... is always the same.*” It again follows that different principles of operation are used and that no combination of the ‘420 and the ‘744 patents could operate as the presently claimed invention does. A similar analysis applies to claim 13.

In any case, we urge that claims 6 and 13 are allowable for at least the same reasons stated above for their parent claims 1 and 9.

Item 4 (Double Patenting 3/3):

The Action states:

4. Claims 7 and 14 are rejected ... over claims 1 of U.S. Patent No. 6,561,420 in view of U.S. 2003/0205615. Though the ‘420 Patent is silent to extensible markup language tagging, the ‘615 art teaches (abstract, for example) so that data can be processed easily with most available software. Therefore, it would have been obvious to an Examiner of ordinary skill in the art to combine the teachings to make the card more convenient for use.

As an initial item, we again respond based on what we believe is the correct standard.

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Next we note that the '615 application was filed May 2, 2002 and published Nov. 6, 2003, and that the present application is based on the '420 patent which was filed April 10, 2001. XML was well known in 2001, and the '420 patent is silent with respect to it merely because its acceptance and use with conventional software (e.g., word processors and databases) was not yet widely established. One of ordinary skill in the art would nonetheless appreciate that data in XML format could be stored in an information card usable with the linear or rotational read mechanisms of the '420 patent.

Accordingly, the mention of XML and inclusion of it in dependent claims in the present application should not be misinterpreted as any form of concession, but rather as an acknowledgement that XML is now widely established and economically important, and to make explicit to all that it clearly is encompassed by the present invention.

In any case, we urge that claims 7 and 14 are allowable for at least the same reasons stated above for their parent claims 1 and 9.

Items 5-6 (Conclusion):

These appear informational in nature and are understood to require no reply.

CONCLUSION

Applicant has endeavored to put this case into complete condition for allowance. It is thought that the objections have all been corrected by amendment and that the rejections have been shown to be unfounded based on the cited prior art references or have been completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

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Respectfully Submitted,



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